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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IA 1506.01A US	7668

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DISCOVISION ASSOCIATES  
INTELLECTUAL PROPERTY DEVELOPMENT  
2355 MAIN STREET, SUITE 200  
IRVINE, CA 92614

EXAMINER
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RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 12/24/2003

45

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

# Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21,47,50-53,56-59,62-65,68-71 and 74-81 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 79-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47,50-53,56-59,62-65,68-71 and 74-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed 11/6/03 has been received and considered. Claims 21,47,50-53,56-59,62-65, 68-71 and 74-81 are pending in the application. Claims 21 and 79-81 are withdrawn from consideration and claims 47,50-53,56-59,62-65, 68-71 and 74-78 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/8/03 has been entered.

#### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Through the numerous iterations of amending, canceling and adding claims, the instant application has gone from a method and apparatus for tracking the distribution of content electronically, to a system and method for transmitting advertising, to what is currently now pending in the application. Due to these changes a more appropriate title is required.

The following title is suggested: SYSTEM AND METHOD FOR PROVIDING  
SELECTIVE ACCESS TO DATA ON AN OPTICAL STORAGE MEDIUM.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 47, 51-53, 57-59, 62, 64, 65, 68, 70, 71, 74 and 75 are rejected under 35

U.S.C. 102(e) as being anticipated by Uranaka et al (U.S. Pat 6,470,085). The claimed invention reads on Uranaka et al as follows:

Uranaka et al discloses (claim 47) a method for providing selective access to data (abstract, col. 1 lines 9-15) on an optical storage medium (col. 1 lines 17-26, col. 2 lines 25-28), comprising providing said data for storage on said optical storage medium (col. 5 lines 21-57, figure 2, 3), requesting that an identifier be incorporated on a burst cut area (BCA) on said optical storage medium in conjunction with said data (reference number 23, figures 2, 4, col. 4 lines 25-31, col. 5 line 58 – col. 6 line 13), and providing pertinent user information (col. 6 line 66 – col. 7 line 5, a users public key is entered on the BCA, because the claim language does not require the user information to be stored in the BCA, examiner also considers a user credit card information that is used as also meeting this limitation), wherein said identifier identifies a specific instance of said optical storage medium (col. 5 lines 21-57), wherein said identifier is read when said optical storage medium is inserted into a device (col. 7 lines 26-33), and said identifier as well as pertinent user information is verified at a separate database (col. 7 lines 54-57, figures 8A, 8B, 15 with supporting descriptions), wherein access to said data is precluded upon unsuccessful verification of said identifier and said pertinent user information (figures 8A, 8B, col. 12 lines 27-56, verifies the medium ID with user information), (claim 53, only the differing limitations will be addressed for each independent claim), a system for providing

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selective access to data on an optical storage medium (figure 1), comprising a receiver for incorporating an identifier on a burst cut area (BCA) on said optical storage medium and a source for providing data to said receiver (col. 4 lines 46-55, col. 5 lines 21-42, because each optical storage medium has been programmed or recorded with not only the desired content but also an identifier as depicted in figures 2-4, it is inherent that this information (identifier, data) provided by an information provider (source), was received by some type of receiver) wherein said data and said identifier are stored on said optical storage medium (col. 5 lines 21-42 figures 2-4), (claim 59) a method for providing selective access to data on an optical storage medium comprising receiving data from a source for storage in said optical storage medium (col. 4 lines 46-55), incorporating an identifier on a burst cut area (BCA) on said optical storage medium along with said data (figures 2-4), (claim 65) system for providing selective access to data on an optical storage medium comprising a source for providing data (col. 4 lines 46-55, information provider), a receiver for receiving said data from said source for storage in an optical storage medium (col. 4 lines 46-55, col. 5 lines 21-42, because each optical storage medium has been programmed or recorded with not only the desired content but also an identifier as depicted in figures 2-4, it is inherent that this information (identifier, data) provided by an information provider (source), was received by some type of receiver), said receiver producing said optical storage medium having an identifier incorporated on a burst cut area (BCA) in conjunction with said data (col. 4 lines 46-55, col. 5 line 21 – col. 6 line 13), wherein said identifier is capable of being read upon insertion into a device and verified at a separate database (only the identifier is verified in this claim language, col. col. 7 lines 54-57, col. 8 line 59 – col. 9 line 13), (claim 71) a method for providing selective access to data on an optical storage medium comprising receiving at a server computer an identifier information read from said optical storage medium on a burst

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cut area (BCA) (figures 8A, 8B, col. 8 line 59 – col. 9 line 13) receiving at a server computer pertinent user information (figures 8B, 15 with related description), verifying said identifier information and pertinent user information using a database (col. 7 lines 54-57, figures 8A, 15), and transmitting an authorization key upon successful verification of said identifier information (col. 2 lines 29-42), (claim 51, 57, 62, 68) wherein said steps of providing said data and requesting that an identifier be incorporated on said optical storage medium are performed by a content provider (col. 4 lines 46-55, col. 6 line 66 – col. 7 line 9, content provider can be either the information provider, or the server 8 which regulates access), (claim 52, 58, 64, 70) wherein said data comprises multimedia data (multimedia is defined as a combination of audio and video, col. 4 lines 46-55, CD-ROM and DVD are multimedia), (claim 74) wherein the identifier information is updated and stored in a BCA database (reference number 60, figures 6A) and (claim 75) further comprising broadcasting one of the identifier information and the updated identifier information (col. 7 lines 54-57, information send to and from the server is considered broadcasting). Specific references to figures and columns should not be considered limiting in any way, the entire disclosure of the reference is considered pertinent.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 50, 56, 63 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Oshima et al (U.S. Pat 6,081,785).

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Uranaka et al teaches most all of the instant invention as applied to claims 47, 53, 59 and 65 above. Uranaka et al fails to teach wherein said providing data, incorporating an identifier and receiver are directed toward an optical disc replicator.

Oshima et al teaches providing data, incorporating an identifier and a receiver are directed toward an optical disc replicator (figure 1, 6, 11, col. 2 lines 61 – col. 3 line 15).

Uranaka et al and Oshima et al are analogous art because they are both related to the distribution of content on optical storage mediums.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the replicator of Oshima et al in the system and method for providing selective access to data of Uranaka et al because Oshima et al teaches simplified access to content on an optical storage medium (col. 1 lines 27-50) while improving security of information (col. 18 lines 58-67).

8. Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Brindze et al (U.S. Pat 5,822,291).

Uranaka et al teaches most all of the instant invention as applied to claim 71 above. Uranaka et al fails to teach (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer, (claim 77) further comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer.

Brindze et al teaches (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer (col. 8 lines 39 – col.

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9 line 8, examiner considers “buy me” as anticipated by the “enhanced multimedia format” and purchasing) and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer (col. 9 lines 1-5).

Uranaka et al and Brindze et al are analogous art because they are both related to the distribution of multimedia on optical storage mediums.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the web and retailer access of Brindze et al in the system and method for providing selective access to data of Uranaka et al because Brindze et al teaches that their invention is directed to a multimedia transaction system that is particularly effective, versatile, inexpensive, and easy to use (col. 3 lines 20-22).

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 47,50-53,56-59,62-65 and 68-78 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Collart (U.S. Pat 6,665,489) – teaches a system and method for tracking the distribution of content electronically.

Shim (U.S. Pat 6,608,804) – teaches providing a optical disk with a unique code written in a burst cutting area, using the code to verify the type of media.



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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399.

The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

A handwritten signature in black ink, appearing to read 'Paul L Rodriguez', with a stylized, flowing script.

Paul L Rodriguez  
Examiner  
Art Unit 2125

PLR  
12/19/03